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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,191	06/20/2001	Kiyohiko Yokota	205494USOXPCT	3013

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EXAMINER

ASINOVSKY, OLGA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/857,191

Applicant(s)
Yokota et al

Examiner
Olga Asinovsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 21, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 5-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 5-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10 6) ☐ Other:

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DETAILED ACTION

The cancellation of claims 1-2 and 4 is noted.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3 and 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farley et al U.S. patent 5,874,512.

The rejection is set forth at pages 2-3 of the office action mailed on 09/24/02, paper No. 6 and is incorporated here by reference.

Applicant's arguments filed 01/21/03 have been fully considered but they are not persuasive.

The new independent claim 10 includes the limitation of the amount of a cyclic olefin in the range of 0.1 to 10 mol% for the formulation of an olefin copolymer composition.

The applicants' argument is that Farley discloses a tackifier resin composition wherein the cyclic olefin can be present in the range of from about 5 to about 90 mole percent, claim 7 at column 35, and even more preferably from about 10 mol% to about 80 mol%, and most preferably from greater than 20 mol% to 75 mol%, column 17, lines 1-9. The argument is that

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Farley in the working examples discloses at least 24 mol% of cyclic olefin. The argument is that Farley fails to exemplify the independent claim 10 limitation of "0.1 to 10 mol% of a cyclic olefin." Also, applicants argue that Farley fails to suggest that the tackifier resin can produce the films and sheets using the olefin copolymer in the present claims. Farley claims that a cyclic olefin can be selected in the range from about 5 to about 90 mol% in his claim 7.

The difference between the present claim 10 and Farley is that the present claim 10 requires the narrow limitation of a cyclic olefin from 0.1 to 10 mol%, whereas Farley discloses a wide ratio from 5 to about 90 mol%. The present claim 10 also requires that "the cyclic olefin and the aromatic vinyl compound account from 0.2 to 50 mol% of the olefin copolymer." In Farley in the working examples (at least 1-10 first examples as calculated by the examiner from the Table 1 at column 23) the amount of the cyclic olefin and the aromatic vinyl compound is 29 mol% to about 39 mol%. Therefore, the total content of the cyclic olefin and the aromatic vinyl compound in Farley is within the range specified in the present claims. Also, Farley does disclose using the resin as a coating or film onto a backing material, column 20, line 54.

It would have been obvious to one of ordinary skill in the art to select a cyclic olefin in Farley's invention in the amount of 5 mol% up to 10 mol% as requires in the present claim 10, since Farley discloses "with regard to specific applications" the content of the ingredients can be selected for obtaining the desired properties, column 20, lines 62-64.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is relevant to show the state of the art knowledge.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is (703) 308-0041. The examiner can normally be reached on Monday to Friday from 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 and (703) 872-9311 after final.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

O.A.

O.A.

March 21, 2003



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700